

REMARKS

I. Introduction

With the cancellation herein without prejudice of claims 11 to 19, claims 1 to 10 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicant thanks the Examiner for considering the previously filed Information Disclosure Statements, PTO-1449 papers and cited references.

II. Rejection of Claims 1 to 4 and 6 Under § 102(b)

Claims 1 to 4 and 6 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,149,340 ("Waycuilis"). It is respectfully submitted that Waycuilis does not anticipate the present claims as amended herein for at least the following reasons.

Claim 1 relates to method for providing a fuel and, as amended herein without prejudice, recites a second fuel fraction in the form of a permeate that is aromatics-enriched. Support for this amendment may be found, for example, on page 2, lines 16 to 24 of the Specification.

Waycuilis describes a method of separating lower boiling hydrocarbons from a hydrocarbon mixture using a membrane. The hydrocarbon mixture described in Waycuilis does not include a second fuel fraction in the form of a permeate that is aromatics-enriched.

To anticipate a claim, the reference must disclose each and every element of the claimed invention. Verdergaal Bros. v. Union Oil Co. of Cal., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). As more fully set forth above, Waycuilis does not disclose, or even suggest, all of the features recited in claim 1. As such, it is respectfully submitted that Waycuilis does not anticipate claim 1.

As for claims 2 to 4 and 6, which depend from claim 1 and therefore include all of the features recited in claim 1, it is respectfully submitted that Waycuilis does not anticipate these dependent claims for at least the same reasons more fully set forth above in support of the patentability of claim 1.

For at least the foregoing reasons, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 1 to 7 Under 35 U.S.C. § 102(e)

Claims 1 to 7 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,972,093. Applicant respectfully submits that U.S. Patent No. 6,972,093 does not anticipate the present claims for at least the following reasons.

The present application claims priority to Application No. 102 55 778.0, filed in the Federal Republic of Germany on **November 29, 2002**. A claim of priority to German Application No. 102 55 778.0 was made, *inter alia*, in the “Combined Declaration and Power of Attorney for Patent Application,” filed on December 1, 2003. Receipt of a certified copy of German Application No. 102 55 778.0 has been acknowledged by the Office, and a certified translation of German Application No. 102 55 778.0 will be submitted under separate cover.

U.S. Patent No. 6,972,093 issued on **December 6, 2005** from U.S. Patent Application Serial No. 10/248,592, filed on **January 30, 2003**, which is *after* the **November 29, 2002** priority date of the present application. In view of the foregoing, it is respectfully submitted that U.S. Patent No. 6,972,093 does not constitute prior art against the present application under 35 U.S.C. § 102(e), or otherwise. Withdrawal of this rejection is therefore respectfully requested.

IV. Rejection of Claims 1 to 7 Under 35 U.S.C. § 103(a)

Claims 1 to 7 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent Application Publication No. 2002/0139111 (“Ueda et al.”) and Waycuilis. It is respectfully submitted that the combination of Ueda et al. and Waycuilis does not render unpatentable the present claims for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure.

In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The Office Action has clearly failed to establish a prima facie case of obviousness.

The present rejection is deficient because the references do not provide a suggestion or motivation for making the proposed combination. Merely because certain reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The Office Action asserts, at page 4, that “Waycuilis teaches a similar process with sweep gas, which, Waycuilis teaches, would improve the process (see paragraph 1 above for details).” Nowhere, however, do the references provide a suggestion or motivation for making the proposed combination.

If the desirability of the combination cannot be found in the prior art, then a rationale must be provided that is reasoned from knowledge generally available to one of ordinary skill in the art, based on established scientific principles, or based on legal precedent established by prior case law. See M.P.E.P. 2144. At least a convincing line of reasoning must be presented to support the rejection. Ex Parte Clapp, 227 U.S.P.Q. 972 (Bd. Pat. App. & Inter. 1985). It is respectfully submitted that the Office Action has not provided a convincing line of reasoning for making the proposed modification. The Office Action states, at page 4, that “[i]t would have been obvious ... to use the teaching of Waycuilis in the teaching of Ueda to have the sweep gas to improve the process.” This is not a convincing line of reasoning but instead a conclusory statement that it would have been obvious to combine the references to achieve an alleged end result, i.e., to improve the process. Moreover, the proposed combination is untenable. A person of skill in the art would not combine the sweeping gas disclosed in Waycuilis (known in the separation of methane and ethane) with the system disclosed in Ueda et al. for separating fuel fractions. Furthermore, Ueda et al. disclose a process based on the separation of fuel fractions due to a high pressure side and a low pressure side of a membrane. If the system disclosed in Ueda et al. was provided with a supply of gaseous fuel, as disclosed in Waycuilis, the use of a high and a low pressure side of a membrane disclosed by Ueda et al. would be lost by using the sweep gas stream disclosed by Waycuilis. Also, the system described in Ueda et al. includes, on the permeate side of a separation device, a vacuum pump and a condenser. Vacuum

pumps are normally destroyed under a continuous supply of a sweep gas stream. For at least these reasons there is no motivation or suggestion to make the proposed combination. Accordingly, the present rejection is apparently based on nothing more than improper hindsight, which cannot support an obviousness rejection. It is respectfully submitted that the combination of Ueda et al. and Waycuilis does not render unpatentable claims 1 to 7.

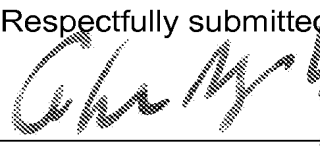
For at least the foregoing reasons, withdrawal of these rejections is respectfully requested.

V. Conclusion

In light of the foregoing, Applicant respectfully submits that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

No fees are believed to be required in connection with this paper. Nevertheless, the Director is hereby authorized to charge any and all fees that may be required in connection with this paper or this application, including any required extension of time fees under 37 C.F.R. §§ 1.17(a) or 1.136, to the deposit account of Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

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